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Date: February 27, 2006 Name: David W. Okey Signature: [signature]

BRINKS HOFER GILSON &LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Wai Kai Wong et al.
Appln. No.:	10/631,881
Filed:	July 31, 2003
For:	Letter Flashing System for Footwear and Personal Articles
Attorney Docket No:	9046/20

Examiner: Guiyoung Lee
Art Unit: 2875

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Attached is/are:

☒ Notice of Appeal and Pre-Appeal Brief Request for Review.
☐ Return Receipt Postcard

Fee calculation:

☐ No additional fee is required.
☐ Small Entity.
☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
☒ A petition or processing fee in an amount of $500 under 37 C.F.R. § 41.20(b)(1).
☐ An additional filing fee has been calculated as shown below:

	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Small Entity Rate	Small Entity Add'l Fee	or	Not a Small Entity Rate	Not a Small Entity Add'l Fee
Total		Minus			x $25=			x $50=	
Indep.		Minus			x 100=			x $200=	
First Presentation of Multiple Dep. Claim					+$180=			+ $360=	
					Total	$		Total	$

Fee payment:

☐ A check in the amount of $_____ is enclosed.
☒ Please charge Deposit Account No. 23-1925 in the amount of $500.
☐ Payment by credit card in the amount of $_____ (Form PTO-2038 is attached).
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

27 Feb. 2006
Date

Respectfully submitted,
[signature]
David W. Okey (Reg. No. 42,959)

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Name of applicant, assignee or Registered Representative

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Our Case No. 9046-20

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Wai Kai Wong et al.

Serial No. 10/631,881

Filing Date: July 31, 2003

For: Letter Flashing System for Footwear and Personal Articles

Examiner: Guiyoung Lee

Group Art Unit No.: 2875

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action mailed December 28, 2005, Applicant has filed this Pre-Appeal Brief Request for Review, as well as the accompanying Notice of Appeal, within two months of the mailing of the final Office Action. The most recent amendments in this application were filed on September 21, 2005, and are already of record.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

1. Claims 1-25 and 27-44 are pending in the application. The claims have been rejected twice and Applicants wish to use the new expedited and abbreviated PTO procedure for appeals.

3. Claims 1-5, 7-11, 13-15, 17-25 and 27-44 were rejected as unpatentable under 35 U.S.C. § 103(a) in view of U.S. Pat. No. 5,457,900 to Avery Roy ("Roy") in view of U.S. Pat. No. 6,776,498 to Kwok Yeung ("Yeung"). The rejection states that Roy discloses all the limitations of the claims, such as Claim 1, except for a switch which operates at a high or low frequency, which is taught by Yeung. The rejection of these claims is traversed because the references do not teach or suggest all the limitations of the claims. In addition, there is insufficient motivation to combine the references.

The references do not teach all the limitations of the claims

Contrary to the rejection, Roy does indeed teach a switch that operates at a low frequency and a higher frequency. See Roy, cols. 1-2, stating that the controller calculates the velocity of the footwear as it moves through a stepping motion. Roy then uses the frequency of steps to calculate a velocity of the footwear. Depending on the velocity, the controller then determines the rate at which the LEDs are to be strobed. Abstract of Roy, lines 3-9. Thus, Roy teaches a switch that operates at a variable frequency, and uses the variability of the frequency to determine the rate at which a given message or character is flashed.

Roy does NOT teach or suggest the Claim 1 limitation of a plurality of lamps, wherein the controller flashes the lamps in a first sequence when the switch closes at a relatively low frequency, and in a second sequence when the switch closes at a higher frequency. Roy teaches an 8-LED display (see Fig. 1) with a pattern that varies quickly so that the LED display can flash a brief message "HI", as shown in Fig. 4B and as described in col. 4, lines 55-65. There is no teaching of first and second sequences whose flashing depends on the switch frequency, but instead a system in which the rate of flashing changes with the frequency of switch closing. Accordingly, Roy does not teach or suggest the limitations of Claim 1.

Yeung teaches a system in which "the motion speed of a person wearing footwear can be estimated by the operation frequency of the contact switch." Col. 7, lines 61-63. When the speed of the footwear reaches a pre-determined threshold, luminous signals are then emitted, and can be varied in a predetermined manner. Abstract of Yeung. Yeung teaches only flashing lights, and does not teach or suggest flashing words, letters, symbols, or messages.

Roy teaches an alphanumeric display, but does not teach or suggest changing the display at different velocities or stepping speeds; Roy only teaches flashing the display at a rate that depends on the wearer's velocity or stepping rate. Yeung teaches a switch operating at a variable rate and does not teach or suggest an alphanumeric display. Yeung adds nothing to Roy, which already discloses a system in which the flashing rate depends on the wearer's velocity or stepping rate.

Thus, the combination of Roy and Yeung does not teach or suggest the invention recited in Claim 1 and fails to make out a prima facie rejection. By the same reasoning, the limitations of independent Claims 20, 24, 30, and 38 are also not taught or suggested by Roy and Yeung and are also allowable. Dependent claims 2-19, 21-23, 25, 27-29, 31-37, and 39-44 are also allowable because they depend from allowable claims.

In addition, numerous of the dependent claims recite limitations that are not taught or suggested in the references. Very few of the dependent claims are considered in the Office Action. For instance, Claim 5 recites two LED displays of at least three lamps each, in which the controller flashes the lamps of the first display when the motion switch is closed at a first frequency, and flashes the lamps of the second display when the motion switch is closed at a relatively higher frequency. The limitations of Claim 5 are not taught or suggested in Roy and Yeung.

Claim 7 recites the system of Claim 1 further comprising a memory that stores data defining at least two patterns of alphanumeric characters, wherein the sequence displayed is response to a frequency of the switch closing. Claim 7 adds a further limitation wherein the stored patterns comprise a sequential pattern, a forward pattern, a reversed pattern, a random pattern, a fade-in sequential pattern, and a fade-out sequential pattern. Roy and Yeung do not teach or suggest these limitations or those of many of the dependent claims. Thus the Office Action does not make out prima facie rejections of the dependent claims.

There is insufficient motivation to combine the references

The Office Action does not state a motivation for combining the references, stating only that it would have been obvious to substitute Yeung's switch for Roy's switch in order to open or close the switch according to a speed of a wearer of lighted footwear. This is precisely what any motion switch accomplishes: the switch closes and opens according to the speed of the wearer. See Roy, col. 3, lines 15-18; see Yeung, col. 4, lines 16-19. Thus, the switch of Yeung adds nothing to the system of Roy.

In order to combine references, there must be some motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. 2143. The rejection merely states that the references CAN be combined, but, as noted above, Roy and Yeung both teach motion switches, and thus Yeung adds nothing to Roy. Therefore, it is not even possible to find a motivation to combine, since the references teach the same art with regard to motion switches.

3. Claims 12 and 16 are rejected as unpatentable under 35 U.S.C. § 103(a) in view of U.S. Pat. No. 5,457,900 to Avery Roy ("Roy") in view of U.S. Pat. No. 6,776,498 to Kwok Yeung ("Yeung"), and further in view of U.S. Pat. No. 6,525,487 to Meng Wei ("Wei"). The rejection admits that Roy does not teach the limitations recited in Claims 12 and 16. The rejection cites Wei, Fig. 3, as teaching a system in which at least one of the first and second pluralities of LEDs is connected to two different voltages in sequence.

Applicants traverse the rejection, because this is not what Wei teaches. Fig. 3 of Wei, and the accompanying text in col. 2, teaches a system in which voltages V1 and V2 are connected only to L3, numeral 43, while voltage V1 is connected only to L1 and L2, numerals 41 and 42. Thus L1 and L2 are connected only to V1, while L3 is connected only to V1 + V2. See col. 2, lines 4-13, stating that V1 is connected to red LED 41 and green LED 42, while the second battery V2 is connected to the blue LED 43.

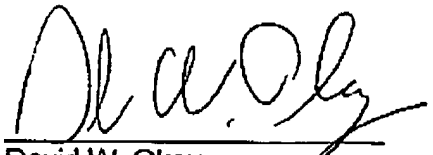
Wei does not teach different voltages applied to the same LED in sequence, and thus does not teach the limitations of Claims 12 and 16. Accordingly, the Office Action fails to make out a prima facie case of obviousness against the claims. Claims 12 and 16 are therefore allowable.

In addition, the rejection provides insufficient motivation for combining the references. As noted above, there is insufficient motivation for combining Yeung with Roy. In the rejection of Claims 12 and 16, the stated motivation is that it would have been obvious to modify Roy's battery system with the two-battery system of Wei in order to provide two different driving voltages to the plurality of LEDs. This does not state a motivation, it merely states that the two references can be combined.

The fact that the references can be combined, however, is not sufficient to establish a prima facie case of obviousness. M.P.E.P. 2143.01 (III). The prior art must also suggest the desirability of the combination. Id. *citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), stating that even if the prior art may be modified in a certain way, there must be a suggestion or motivation in the references to do so, in order to show obviousness. Accordingly, the Office Action fails to make out a prima facie case of obviousness for Claims 12 and 16, and also for Claims 1-11, 13-15, 17-15 and 27-44, as discussed above.

5. The Office Action fails to make out a prima facie case of rejection for the claims of the application because the references do not teach all the limitations of the claims, and also because there is insufficient motivation to combine the references. The undersigned respectfully requests that the rejections in the present application be withdrawn and that the claims of the application be allowed.

Respectfully submitted,



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